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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/045,799	03/23/1998	HIDEYUKI HAYASHI		1410
7590 03/01/2004				
SUGHRUE MION ZINN MACPEAK & SEAS		EXAMINER		
2100 PENNSYLVANIA AVENUE N W		TAMAI, KARL I		
WASHINGTON, DC 20037				
		ART UNIT	PAPER NUMBER	
		2834		

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/045,799

Applicant(s)

HAYASHI ET AL.

Examiner

Tamai IE Karl

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9-14 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-14 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. This application contains claims 24-26 are drawn to the non-elected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Specification

2. The objection to the specification is withdrawn.
3. The objection to the amendment filed 6/3/2003 is withdrawn.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the vertical and horizontal extension of the deformation preventer must be shown or the features canceled from the claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 21-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

In regards to claim 21-23 the specification does not have a written description of the deformation preventer extending vertical and horizontal to the top and bottom surfaces of the conductor or the end portions of the wires. The examiner will assume the vertical and horizontal directions are along traverse across the wire and along the longitudinal edge (as shown in Peterson), but there is no support in the specification for the deformation preventer extending vertical and horizontal to the conductor.

7. The rejection of Claims 1-6 9-14, and 21-23 under 35 U.S.C. 112, second paragraph, is withdrawn.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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9. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Onishi et al. (Onishi)(US 6162381). Onishi teaches an insert conductor having a wiring section with a plurality of wires inside an outer frame with connections to the outer frame 110a with a deformation preventer 112 provided on the conductors covering at the least the ends of wire (bottom 112 section in figure 3 below the four holes). The deformation preventer engages discrete wire sections to support the wires after cutting.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Onishi et al. (Onishi)(US 6162381) in further view of Yoshida (JP 4-64414). Onishi teaches every aspect of the invention, as discussed above, except the deformation preventer composed of polyphenylene sulfide resin. Yoshida teaches that polyphenylene sulfide is used in is used in integrated circuits as an insulating layer. It would have been obvious to a person skilled in the art at the time of the invention to construct the insert conductor of Onishi with the deform preventer made of polyphenylene sulfide resin because Yoshida teaches that polyphenylene sulfide resin provides good adhesion and a firm adhesive property, and because it has been held that it is within the ordinary skill in the art to select a know material on the basis of suitability for the intended use (see *In re Leshin*, 125 USPQ 416).

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12. Claims 5, 9-13 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Applicant's admitted prior art and Onishi et al. (Onishi)(US 6162381). The Applicant's admitted prior art teaches every aspect of the invention, as discussed above, except an insulating member to prevent the conductor from being deformed by resin injection during the resin molding and the insulating member covering the ends of the conductor. Onishi teaches the insert conductor with a resin deformation preventer 112, and an overmold 106. Onishi teaches the resin insulator covering the ends of the conductor. It is inherent that the deformation preventer extends across the wire and along the wire (vertical and horizontal). It would have been obvious to a person skilled in the art at the time of the invention to construct the brush holder of the Applicant's admitted prior art with the deformation preventer of Onishi to provide a cost effective way to assemble the electrical components on the molded unit.

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art(AAPA) and Onishi et al. (Onishi)(US 6162381), in further view of Yoshida (JP 4-64414). AAPA and Onishi teach every aspect of the invention, as discussed above, except the deformation preventer composed of polyphenylene sulfide resin. Yoshida teaches that polyphenylene sulfide is used in integrated circuits as an insulating layer. It would have been obvious to a person skilled in the art at the time of the invention to construct the insert conductor of AAPA and Onishi with the deform preventer made of polyphenylene sulfide resin because Yoshida teaches that polyphenylene sulfide resin provides good adhesion and a firm adhesive property.

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14. Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Applicant's admitted prior art and Onishi et al. (Onishi)(US 6162381), in further view of Waratani et al. (Waratani)(JP 4-64414). The Applicant's admitted prior art and Onishi teach every aspect of the invention, as discussed above, except a deformation preventer on both sides of the conductor. Waratani teaches the deformation preventer 2 on both sides of the conductor. It would have been obvious to a person skilled in the art at the time of the invention to construct the brush holder of the Applicant's admitted prior art and Onishi with the deformation preventer on both sides as taught by Waratani to support the conductor during the molding process.

15. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art(AAPA), Onishi et al. (Onishi)(US 6162381) and Waratani et al. (Waratani)(JP 4-64414), in further view of Yoshida (JP 4-64414). AAPA, Onishi, and Waratani teach every aspect of the invention, as discussed above, except the deformation preventer composed of polyphenylene sulfide resin. Yoshida teaches that polyphenylene sulfide is used in is used in integrated circuits as an insulating layer. It would have been obvious to a person skilled in the art at the time of the invention to construct the insert conductor of AAPA, Onishi, and Waratani with the deform preventer made of polyphenylene sulfide resin because Yoshida teaches that polyphenylene sulfide resin provides good adhesion and a firm adhesive property.

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Response to Arguments

16. Applicant's arguments filed 12/08/2003 have been fully considered but moot in view of the new ground of rejection.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl I.E. Tamai at (571) 272 - 2036.

The examiner can be normally contacted on Monday through Friday from 8:00 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Nestor Ramirez, can be reached at (571) 272 - 2034. The facsimile number for the Group is (703) 872 - 9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Karl I Tamai
PRIMARY PATENT EXAMINER
February 7, 2004



KARL TAMAI
PRIMARY EXAMINER